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In re Application of GUO et al.
Application No.: 10/019,883
PCT No.: PCT/CN00/00296
Int. Filing: 30 September 2000
Priority Date: None
Attorney Docket No.: 42390.P9270
For: METHOD AND SYSTEM FOR
GENERATING AND SEARCHING AN OPTIMAL
MAXIMUM.....

: DECISION ON PETITION
: UNDER 37 CFR 1.47(a)

This is a decision on applicant's petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 26 September 2006, to accept the application without the signatures of joint inventor Qing Guo. Applicant's request for a four month extension of time is granted.

BACKGROUND

On 27 December 2001, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 10 April 2006, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, that an oath or declaration in accordance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required.

On 26 September 2006, applicant filed the instant petition along with a declaration, executed by the joint inventors on behalf of the nonsigning inventor. The petition under 37 CFR 1.47(a), in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), requested the acceptance of the application without the signature of inventor Qing Guo, alleging that Mr Guo refused to sign the application and is now unavailable.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(g), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

The petition included the requisite petition fee, satisfying Item (1). Item (3) is satisfied because the last known addresses of non-signing inventor was provided.

With regard to item (4), the declarations executed by the available joint inventors on their behalf and on behalf of the non-signing inventor were submitted. However, the declaration executed by Baosheng Yuan was altered.

Section 602.01 of the MPEP states the following:

The wording of an oath or declaration cannot be amended, altered or changed in any manner after it has been signed. If the wording is not correct or if all of the required affirmations have not been made, or if it has not been properly subscribed to, a new oath or declaration must be required....

Any changes made in ink in the application or oath prior to signing should be initialed and dated by the applicants prior to execution of the oath or declaration. The Office will not consider whether non-initialed and/or nondated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration.

The changes made in the declaration executed by inventor Yuan were not dated and initialed or signed. Therefore, a new acceptable oath or declaration executed by Baosheng Yuan is required to satisfy the requirements of 35 U.S.C. 371 (c)(4) for entrance into the national stage in the United States. Item (4) is not yet satisfied.

Inventor's Refusal to Sign

With respect to Item (2) above, the declaration by Kristin A. Morrow, assistant for the U.S. attorney responsible for prosecution in the USPTO, was attached to the petition, detailing the efforts made to obtain the nonsigning inventor's signature. However, the declaration detailed several attempts to contact the nonsigning inventor via his employee email address, where he no longer was employed. Any further diligent efforts to locate and contact the nonsigning inventor were not provided.

Ms Morrow states that a copy of declaration and power of attorney was sent to Mr. Guo. The emails sent to Mr. Guo requesting his signature on the application did not indicate that a copy of the complete application (including specification, claims and any drawings along with the declaration) was provided to the nonsigning inventor.

Petitioner has not provided evidence that a complete copy of the application papers, including specification, claims and drawings and declaration, were provided to Mr Guo. What is required is that Mr. Guo be presented with a copy of all of the national stage application papers (specification, including claims and drawings, oath or declaration) for this application. Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. The fact that the papers were returned as "undeliverable" cannot be construed as a refusal to sign. It may be that the nonsigning inventor was at work, out of town or in the hospital when the attempt to deliver the papers was made. It is unclear how many attempts to deliver the papers were made before the registered mail was returned on 11 September 2006. See Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or

Refusal.¹

Unavailability of Inventor

With respect to counsel's inability to find or reach Mr. Guo, Petitioner does not demonstrate what "diligent efforts" were undertaken by counsel to locate Mr. Guo and obtain his signature on the declaration. Ms. Morrow states that the copy of the declaration and power of attorney were sent to Mr. Guo and were returned by the postal service as undeliverable.

As indicated in the MPEP Section 409.03(d), where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, diligent efforts made to locate Mr. Guo were not pursued and documented, such as Internet searches, contact with the joint inventors to obtain Mr. Guo's current address, a forwarding address or current email address and/or current employer. No attempt to reach Mr. Guo by telephone was made. No request from the Postal Service for his forwarding address was made. Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a "diligent effort" was made. Petitioner's statement of facts under 37 CFR 1.47(a) does not indicate that any search for Mr. Guo's new

¹ A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.... It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

(Emphasis added.)

address was made. Since no attempts to locate inventor Guo were documented, it can not be concluded that "a diligent effort" was made to locate the non-signing inventor.

The action taken by petitioner is not sufficient to prove that "a diligent effort" was made to contact the nonsigning inventor. Under these circumstances, it cannot be concluded that Mr. Guo is unavailable to sign the application.

In sum, Petitioner has satisfied Items (1) and (3) above. For Item (4), a newly executed declaration by Baosheng Yuan is required. Moreover, Petitioner has not satisfied Item (2) by demonstrating: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 10/019,883 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature and Mr. Guo's refusal to sign, either in writing or by telephone, these documents or (2) a first hand statement of the "diligent efforts" made to contact the nonsigning inventor Qing Guo. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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